

REMARKS

Reconsideration and allowance of the subject application are respectfully requested, in light of the above claim amendments and the following comments.

Status of the Claims

Claims 1-75 are pending in this application, with Claims 1, 11, 17, 44, 51-55 and 66 being independent. Claims 1-16, 24-37 and 51-55 have been withdrawn from consideration.

Support for the Above Claim Amendments

Claims 17, 22, 44, 66, 68, and 73-75 have been amended herein.

As previously worded, independent Claims 17, 44, and 66 all called for the combination of (a) a transfer-resistant basecoat composition containing a cross-linked resinous silicone with (b) an overcoat composition consisting of or containing, as a wetting agent, a liquid polymeric hydrocarbon having a number average molecular weight greater than about 650. Claim 44 specifies that the polymeric hydrocarbon is an alpha olefin polymer. Claim 66 specifies that the resinous silicone is a trimethylsiloxysilicate and that the polymeric hydrocarbon is an alpha olefin polymer.

Applicants have now added to those claims the additional limitation that the overcoat composition be “substantially devoid of non-volatile silicone oils.” As will be explained, this helps distinguish the claimed cosmetic over the prior art. Also, it serves to better

define the invention, for when the basecoat composition contains a resinous silicone, it is generally undesirable to include a non-volatile silicone oil in the overcoat composition, as it will cause a loss of transfer resistance.

Example 2 in Applicants' specification discloses the results when 58 different overcoat compositions were applied over a transfer-resistant basecoat containing a resinous silicone. Of those 58 different combinations, four meet the limitations of Claims 17, 44, and 66. Those are the combinations in which one of the following polymeric hydrocarbons was used as the overcoat composition: Indopol H-100, Indopol H-50, Parapol 700, and Synton PAO 100. (See page 29, items 1, 3, 6, and 7 under the heading "HYDROCARBONS.") In all four of those combinations there was no non-volatile silicone oil in the overcoat composition, and all four combinations performed well, getting scores of 1 or -1 on a transfer-resistance scale of 0 to 3, in which 0 is the highest possible score and 3 is the lowest. Id.

In contrast to those four acceptable combinations, when four different non-volatile silicone oils were applied overtop the Example 2 basecoat, all earned the lowest possible score, 3 -- meaning that the non-volatile silicone oil actually removed the basecoat. Those four non-volatile silicone oils were Dimethicone fluid (350 cs), Dow Corning 1248 fluid, Dow Corning 1401 fluid, and Fluorosilicone. (See page 30, items 7-10 in the section headed "MISCELLANEOUS.")

Applicants submit that this disclosure in Example 2 clearly allows persons of ordinary skill in the art to recognize that Applicants invented the combined use of a resinous-silicone-containing basecoat composition with an overcoat composition that contains a polymeric

hydrocarbon having a number average molecular weight greater than about 650 and that is substantially devoid of non-volatile silicone oils. Therefore, the addition of the claim limitation that the overcoat composition is “substantially devoid of non-volatile silicone oils” does not constitute “new matter.” See Union Oil Co. of Cal. v. Atl. Richfield Co., 208 F.3d 989, 997, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000) (“The written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” (citation omitted)).

Prior-Art Rejections

In the latest Office Action, Claims 17-19, 38-44 and 46-50 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,074,654 (Drechsler et al.) in view of U.S. Patent No. 4,699,780 (Jennings) and U.S. Patent No. 5,970,989 (Litton). Claims 21, 23, 58 and 59 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Jennings and Litton, further in view of Manufacturing Chemist and ExxonMobile Chemical Technical Data. Claims 21, 22, 56 and 57 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Jennings, and Litton, further in view of U.S. Patent No. 4,935,228 (Finkenauer et al.) and Amoco Technical Data. Claim 20 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Jennings and Litton, further in view of U.S. Patent No. 6,509,009 (Nichols et al.). Claim 45 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Jennings, and

Litton, further in view of U.S. Patent No. 3,871,543 (Chadfield et al.). Claims 60-66, 68-72 and 75 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler et al., Jennings, and Litton, further in view of Finkenaar et al., Amoco Technical Data and STN-REGISTRY. Claims 67, 73 and 74 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler, Jennings, and Litton, further in view of Finkenaar et al. and Amoco Technical Data. These rejections are respectfully traversed.

Applicants' invention as recited in independent Claim 17, as amended, is directed to a multipack lip cosmetic including at least two separate receptacles in a single stock keeping unit. The first receptacle contains an anhydrous, pigmented, transfer-resistant composition that includes a film-forming, cross-linked, resinous silicone; a volatile solvent; and pigment. The second receptacle contains a wetting agent overcoat composition for the transfer resistant composition. The wetting agent overcoat composition includes a wetting agent that is non-reactive with, but affinitive to, the transfer-resistant composition. The wetting agent is a liquid polymeric hydrocarbon having a number average molecular weight greater than about 650, and the wetting agent overcoat composition is substantially devoid of non-volatile silicone oils.

Applicants' invention as recited in independent Claim 44, as amended, is directed to a multipack lip cosmetic that includes at least two separate receptacles in a single stock keeping unit. The first receptacle contains an anhydrous, pigmented, transfer-resistant composition that includes a film-forming, cross-linked, resinous silicone; a volatile solvent comprising isododecane; and pigment. The second receptacle contains a wetting agent overcoat composition for the transfer resistant composition. The wetting agent overcoat composition

includes an alpha olefin polymer that is a liquid polymeric hydrocarbon that is non-reactive with, but affinitive to, the transfer resistant composition and has a number average molecular weight greater than about 650. The wetting agent overcoat composition is substantially devoid of non-volatile silicone oils.

Applicants' invention as recited in independent Claim 66, as amended, is directed to a multipack lip cosmetic that includes at least two separate receptacles in a single stock keeping unit. The first receptacle contains an anhydrous, pigmented, transfer-resistant composition that includes (a) a film-forming trimethylsiloxysilicate, (b) a solvent component in which the trimethylsiloxysilicate is dissolved or dispersed, the solvent component comprising isododecane and a silicone oil, (c) pigment, and (d) a viscosity increasing amount of a quaternized hectorite. The second receptacle contains a wetting agent overcoat composition for the transfer resistant composition. The wetting agent overcoat composition includes an alpha olefin polymer that is a liquid polymeric hydrocarbon that is non-reactive with, but affinitive to, the transfer-resistant composition, and that has a number average molecular weight greater than about 650. The wetting agent overcoat composition is substantially devoid of non-volatile silicone oils.

For the following reasons, Applicants submit that the cited art fails to teach important features of Applicants' claimed invention.

Drechsler et al. is directed to transfer-resistant cosmetic compositions and discloses the complementary use of a basecoat composition and an overcoat composition. Regarding the overcoat composition, the Examiner acknowledges that Drechsler et al. fails to

teach or suggest the use of a liquid polymeric hydrocarbon that has a number average molecular weight greater than about 650. To remedy this deficiency, the Examiner cites to Jennings.

Jennings is directed to a lip cosmetic composition that may be used as a lipstick, a lip balm, or as an undercoat or overcoat for use with other lip cosmetics. (See col. 2, lines 39–35.) The Examiner contends that it would be obvious to modify Drechsler et al.'s basecoat/overcoat combination by substituting an overcoat composition from Jennings for the overcoat that Drechsler et al. discloses. Jennings' compositions contain a certain type of resin, a polysiloxane, a polyolefin, and at least one paraffin or wax hardening agent. (See col. 1, line 44 to col. 5, line 35.) Jennings discloses just one example that is said to be suitable as an "overcoat." That is Example 2. In that example, the polysiloxane that is used is Dow Corning Fluid 556. (See col. 4, lines 18-23.) Dow Corning Fluid 556 is a polyphenylmethylsiloxane, which is a non-volatile silicone oil. Since the only Example in Jennings that is said to be suitable as an "overcoat" contains a non-volatile silicone oil, Applicants submit that Jennings does not teach or suggest an overcoat composition that is substantially devoid of non-volatile silicone oils, as is now recited in the independent claims. Thus, even assuming *arguendo* that modifying Drechsler et al. by substituting for its overcoat the overcoat of Jennings would have been prima facie obvious to one of ordinary skill in the art, the resulting combination still would not be Applicants' claimed invention.

Litton was cited for teaching a multipack cosmetic. Litton is not understood to remedy the above-noted deficiencies of Drechsler et al. and Jennings.

Manufacturing Chemist, ExxonMobile Chemical Technical Data, Finkenaur et al., and Amoco Technical Data were cited for teaching specific polyolefin compounds. None of these references, however, is understood to remedy the above-noted deficiencies of Drechsler et al. and Jennings.

Nichols et al. was cited for teaching a makeup remover composition. Chadfield et al. was cited for teaching a container made of styrene. STN-REGISTRY was cited for teaching a quaternized hectorite. None of these references, however, is understood to remedy the above-noted deficiencies of Drechsler et al. and Jennings.

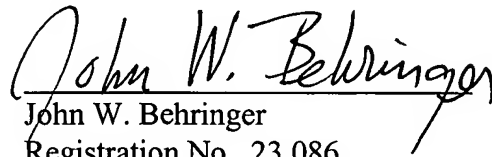
Accordingly, Applicants submit that none of the cited references, whether taken alone or in combination (assuming such a combination is proper) teaches or suggests important features of Applicants' claimed invention. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are therefore requested.

Applicants submit that the present invention is patentably defined by independent Claims 17, 44 and 66. Dependent Claims 18-23, 38-43, 45-50, 56-65 and 67-75 are also patentable, in their own right, for defining other important features of the present invention, in addition to those recited in the independent claims.

Applicants submit that this application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,


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